



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,187	04/26/2001	Thomas M. Baer		2124

7590 09/08/2004
Rimas Lukas
465 Kelly Ave., #E
Half Moon Bay, CA 94019

EXAMINER

CROSS. LATOYA I

ART UNIT	PAPER NUMBER
----------	--------------

1743

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/844,187	Applicant(s) BAER ET AL.	
	Examiner LaToya I. Cross	Art Unit 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 79-82 and 94-108 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-13, 79-82 and 106-108 is/are allowed.
- 6) ☒ Claim(s) 1-4, 93, 97-100 and 104 is/are rejected.
- 7) ☒ Claim(s) 5, 94, 95, 96, 101, 102, 103 and 105 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: <u>09-04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to Applicants' amendments filed on June 10, 2004.

Claims 1-13, 79-82 and 93-108 are pending.

Withdrawal of Rejections from Previous Office Action

- The anticipatory rejection over Colpan and obviousness rejection over Colpan in view of Baer are withdrawn in view of Applicants' amendments to recite that the carrier receiving portion mates with the carrier, closes the first opening, seals the first opening to prevent fluid flow and forms a reservoir.

Claim Observations

- Claim 4 recites "wherein some non-specifically transferred material is excluded from the resevoir". The claim is unclear because non-specifically transferred material is not recited as a position limitation. It is suggested that Applicants' amend claim 4 to recite 'wherein non-specifically transferred material is present on the carrier and wherein some non-specifically transferred material is excluded from the reservoir'.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

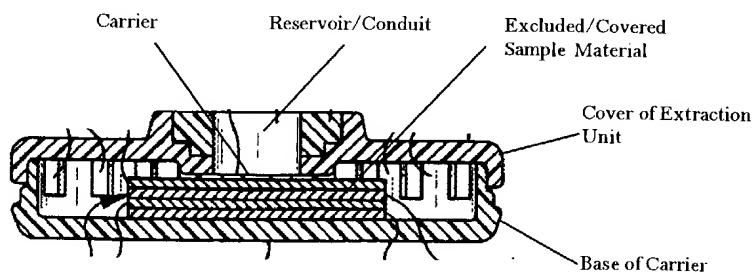
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1743

2. Claims 1-4, 93, 97-100 and 104 are rejected under 35 U.S.C. 102(b) as being anticipated by US patent 6,057,165 to Mansour.

Mansour teaches an assay device for collecting and testing biological samples. The device comprises a base (45) having a composition material (41) onto which a biological sample is disposed. The base having the biological sample is considered to be a "carrier". The carrier mates with a cover portion (46). The cover portion has an aperture (48), which is a conduit running from the top of the cover to the bottom of the cover. When the cover is mounted onto the base, the sample carrier closes the bottom part of the conduit and forms a reservoir. The portions of the carrier on both sides of the conduit are not in communication with the conduit. In fact a part of the cover covers a portion of the carrier and excludes a part of the carrier from being in communication with the conduit. See figure 5 labeled below. Mansour further teaches that a well (10) may be mated with cover at the conduit for delivering fluids into the conduit (col. 12, lines 1-7).

It is noted that Mansour do not disclose the cover having the conduit as an extraction unit. However, in the claims the extraction unit is defined as having a carrier receiving portion and a conduit extending between a first opening and a second opening of the carrier-receiving portion. Since Mansour teach such, the claim limitations are met.



Allowable Subject Matter

3. Claims 6-13, 79-82 and 106-108 are allowed.
4. Claims 5, 94, 95, 96, 101, 102, 103 and 105 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record fails to teach or fairly suggest an extending feature or stand-off portion on the carrier. The prior art of record also fails to teach or suggest a transfer film on the carrier. Transfer film has been interpreted in light of the specification as a film adapted for absorbing energy delivered by a laser pulse or multiple laser pulses and further adapted for expanding and adhering to the target cells (specification page 10, paragraph 52). Further, the prior art of record fails to teach or suggest a method for extracting matter wherein a carrier having a transfer film is mated to an extraction device.

Response to Arguments

5. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.
6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until

Art Unit: 1743


after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaToya I. Cross whose telephone number is 571-272-1256. The examiner can normally be reached on Monday-Friday 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lic


Jill Warden
Supervisory Patent Examiner
Technology Center 1700